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10/053,541	11/02/2001	Victor Lu	3561-102	6064
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EXAMINER				
SERRAO, RANDHI N				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/053,541

**Applicant(s)**

LU ET AL.

**Examiner**

RANODHI N. SERRAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 24 November 2008 have been fully considered but they are not persuasive.
2. Applicant argued,

*Applicants traverse this rejection on the grounds that the application includes JavaScript code in an Appendix that successfully operates to implement the functions recited in the claims.*

*This is not simply a matter of saying 'what' you want to do without providing the 'how'- instead, the specification includes real code that operates in the fashion stated. One knowledgeable in the art would thus have a working example of code that is capable of "operating on the visitor computer to obtain web browsing data." The code included in Appendix A sets variables according to data collected by operation of the code.*

3. The examiner respectfully disagrees and based on Applicant's remarks, the Examiner is convinced that claims 1-8 and 14-17 also fail to comply with the enablement requirement of 35 U.S.C. 112, first paragraph. There is no description in the entire disclosure including the Appendix to enable one of ordinary skill in the art to make and/or use the claimed *data mining code*.
4. Applicant has verified the Examiner's assertion that the Appendix only describes JavaScript code and not data mining code. JavaScript code is tied to the claimed *cookies processing script* limitation since page 3, lines 27-29 of Applicant's Specification specifically states, "The present invention instead embeds **all cookie** generating and processing algorithms within the **JavaScript** of the web pages sent to the client node." And Appendix A states, "(Client-Based Cookie Generation)" and starts with the programming tag `<script LANGUAGE="javascript">` and ends with the programming

tag **</SCRIPT>** (see specification page 15 and page 21). One of ordinary skill in the art would conclude that any code within those tags is in JavaScript and since the Applicant points to the Appendix to state that it includes data mining code is just confirming the examiner's statement that the claimed *cookie processing script* and *data mining code* are one and the same. Thus the prior art of record does not have to recite *data mining code*, only *cookie processing script* in order to read on the claimed invention.

5. Applicant also rebuts the examiner by stating: "Furthermore, one knowledgeable in the art would recognize that the data variables gathered such as those named above correspond to "web browsing data." This data is also referred to as "new events" in the specification (page 11, line 44), e.g. new browsing data that occurred since **the cookie** was last set, and to the **JavaScript code** described at several other places within the specification, e.g. page 1, lines 25-30. A subroutine then writes **a new cookie value** in view of the old cookie and the new events." This again confirms the Examiner's assertion that only *cookie processing script* is being operated by Applicant's invention.

6. Applicant also remarked,

*The teachings of the newly cited Wagner reference seek to prevent operation of cookies, not implement them as in the present invention.*

7. This statement is irrelevant to the rejections since Wagner discloses each and every limitation of the claimed invention.

8. Applicant further stated,

*There is no mechanism within Wagner for allowing a third party to track the information (e.g. claim 2).*

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*Standard cookies and cookie-setting processes do not operate cookie processing script on the web browsing data to obtain new cookie values (e.g. claim 1). Instead, cookie values are set in advance by a cookie server. Such values are not determined at the visitor computer, and such values are not set in consideration of the web browsing data obtained at the visitor computer via the data mining code. Features of the claim are thus missing from Wagner and thus the prior art of record. Reconsideration and removal of the rejection is respectfully requested.*

9. In col. 3, lines 15-41, Wagner specifically states: "For example, a **JAVA applet** may be imbedded in an HTML file, sent to a user's computer and executed by an interpreter in the browser without the user's knowledge. Such programs may be used to gain unauthorized access to resources or data on the user's computer. Additionally, these interpretive language programs may include **cookie commands** that identify **tracking data** as discussed above." Therefore it is clear that Wagner allows a third party to track the information. Furthermore in col. 2, lines 32-53, Wagner states: "Other known methods of passing cookie data to a client program include using a **Javascript data object** or a **Javascript program** that accesses the "cookies.txt" file stored at the client computer." Therefore Wagner teaches the claimed limitations.

10. Applicant moreover remarked,

*The Examiner had previously held, in an Office Action dated May 18, 2007, that Bharat fails to teach the method of embedding data mining script within a web page and operating the data mining script on the client node. Bharat still fails this test, making rejection of the claims under §102(e) inappropriate.*

11. In view of the newly applied rejections under 35 U.S.C. 112, first paragraph and the lack of evidence in the Applicant's disclosure that the claimed *data mining script* and *cookie processing script* are distinct from one another, Bharat reads on the claimed invention.

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12. Applicant further argued,

*Citing to the portion identified by the Examiner (Pogue, Col. 7, lines 11-22), Pogue instead only transmits a new cookie from the tracker 310 to the browser 302 thereby replacing the cookie on the visitor computer. Pogue does not teach that the cookie is then attached to an image request associated with a designated source.*

13. The Examiner respectfully disagrees. In col. 6, lines 52-66, Pogue states: "As in the first implementation, the browser 302 cannot locate a file in the cache memory of the client computer 200 having the URL following the <IMG> tag, thereby causing the tracker message to be directed from the browser 302 to the tracker 310." Therefore Pogue teaches the claimed invention.

14. The Examiner points out that the Applicant has failed to address the rejections under 35 U.S.C. 112, second paragraph. Therefore these rejections are maintained.

15. The examiner points out that the pending claims must be "given the broadest reasonable interpretation consistent with the specification" [In re Prater, 162 USPQ 541 (CCPA 1969)] and "consistent with the interpretation that those skilled in the art would reach" [In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999)]. In conclusion, upon taking the broadest reasonable interpretation of the claims, the cited references teach all of the claimed limitations. And the rejections are maintained. See below.

### ***Specification***

16. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not contain any support for the claim

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limitation, "operating the data mining code on the visitor computer to obtain web browsing data." And the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See below rejections.

***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 1-8 and 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

19. Claim 1 recites the limitation, "operating the data mining code on the visitor computer to obtain web browsing data." This limitation is not mentioned in the applicant's specification. In page 4 of the Appeal Brief filed on 25 May 2006, the applicant alleges that this limitation is "described in Spec. page 2, lines 22-31." However, the examiner can find no mention of "operating... data mining code" on page 2 of applicant's specification. In fact, all of the recitations of "data mining code" in the claims seem to be referring to JavaScript code or cookie processing script. Page 2,

lines 22-31 of the specification as well as appendix A, which the applicant points to, describes JavaScript code. The only mention of "data mining code" is on page 10, lines 7-12, but this does not provide the basis for the above-mentioned claim limitation. This leads to the fact that the cookies processing script and the data mining code are one and the same. And since there is no mention of "operating the data mining code on the visitor computer to obtain web browsing data" in the applicant's specification only "operating the cookie processing script on the web browsing data to obtain new cookie values," the examiner treats these two limitations in the claims to be the same for the purposes of examination.

20. Claim 14 similarly recites "operating the data mining script on the client node." Therefore it is rejected under the same rationale as claim 1. Claims 2-8 and 15-17 are rejected based on their dependencies on claims 1 and 14.

21. Claims 1-8 and 14-17 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See above response to arguments.

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



23. Claims 1-8 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
24. Claim 1 recites the limitation "the new cookie" in line 10. There is insufficient antecedent basis for this limitation in the claim.
25. Claim 14 recites the limitation "a web page" multiple times in lines 1 and 3. It is unclear whether the second recitation refers to the first or not.
26. Claims 2-8 and 15-17 are rejected based on their dependencies on claims 1 and 14.

***Claim Rejections - 35 USC § 102***

27. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
28. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Wagner (6,085,224).
29. As per claim 1, Wagner teaches a method for tracking and reporting traffic activity on a web site comprising the steps of: storing a web page on a first server coupled to a wide area network, said web page having web page code and data mining code including a cookie processing script; uploading the web page to a visitor computer responsive to a request over the wide area network from the visitor computer (col. 1, line 59-col. 2, line 53); operating the data mining code on the visitor computer to obtain web browsing data; and operating the cookie processing script on the web browsing

data to obtain new cookie values (col. 3, lines 15-41); and storing the new cookie on the visitor computer including the new cookie values (col. 2, lines 32-53).

30. Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Bharat (6,810,395).

31. As per claim 14, Bharat teaches a method for analyzing activity on a web page of a web site (col. 4, lines 50-64) comprising the steps of: embedding data mining script within a web page; embedding cookie processing script, associated with a different domain than a domain of the web page, within the web page (col. 5, line 8-25); sending the web page to a client node (col. 9, lines 27-41); operating the data mining script on the client node; operating the cookie processing script on the client node (col. 6, lines 41-50); and returning data to the different domain resulting from the operation steps (col. 10, lines 27-32).

32. As per claim 15, Bharat teaches a method, wherein the step of operating the cookie processing script on the client node includes: reading a cookie value from the client node (col. 3, lines 5-15); tracking events on the client node (col. 9, line 60-col. 10, line 7); processing cookie value based on the tracked events to obtain a new cookie value; and writing a new cookie value to the client node (col. 9, line 60-col. 10, line 19).

***Claim Rejections - 35 USC § 103***

33. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

34. Claims 2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner as applied to claim 1 above, and further in view of Pogue et al. (6,112,240).

35. As per claim 2, Wagner teaches the mentioned limitations of claim 1 above but fails to teach a method, further comprising the step of receiving the new cookie values at a second server. However, Pogue et al. teaches a method, further comprising the step of receiving the new cookie values at a second server (see Pogue et al., col. 8, lines 52-59). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner to a method, further comprising the step of receiving the new cookie values at a second server in order to obtain client information relating to a web page in a World Wide Web site by utilizing a tracker tag in the code of the web page for initiating a client information tracking program (see Pogue et al., col. 2, lines 12-26).

36. As per claims 6-8, the above-mentioned motivation of claim 2 applies fully in order to combine Wagner and Pogue et al.

37. As per claim 6, Wagner and Pogue et al. teach a method, wherein the step of generating a new cookie includes the step of operating the cookie processing script on an old cookie associated with the web page and previously stored on the visitor computer (see Pogue et al., col. 7, lines 11-22).

38. As per claim 7, Wagner and Pogue et al. teach a method, further including the step of overwriting the old cookie with the new cookie (see Pogue et al., col. 7, lines 11-22).

39. As per claim 8, Wagner and Pogue et al. teach a method, further including the steps of: detecting that an old cookie exists on the visitor computer associated with the web site; tracking events on the visitor computer; processing the old cookie using cookie processing code in view of the tracked events to obtain new cookie values; and replacing the old cookie values with the new cookie values (see Pogue et al., col. 6, line 52-col. 7, line 22).

40. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat as applied to claim 14 above, and further in view of Pogue et al.

41. As per claim 16, Bharat teaches the mentioned limitations of claim 14 above but fails to teach a method, wherein the step of returning data includes the steps of: embedding data within an image request associated with a designated URL source; and sending the image request to the URL source. However, Pogue et al. teaches a method, wherein the step of returning data includes the steps of: embedding data within an image request associated with a designated URL source; and sending the image request to the URL source (see Pogue et al., col. 7, lines 11-22). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bharat to a method, wherein the step of returning data includes the steps of: embedding data within an image request associated with a designated URL source; and sending the image request to the URL source in order to ascertain if the web browser 302 is still on, to record the time of each web page access, and also to obtain other information regarding the client computer (see Pogue et al., col. 5, lines 55-67).

42. As per claim 17, the above-mentioned motivation of claim 16 applies fully in order to combine Bharat and Pogue et al. Bharat, Pogue et al., and de l'Etraz et al. teach a method, further including the steps of: compiling the web browsing data into a web page traffic report; and posting the report for viewing over the wide area network (see Pogue et al., col. 4, lines 30-60).

43. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner and Pogue et al. as applied to claims 1 and 2 above, and further in view of Davis et al. (2002/0040395). Wagner and Pogue et al. teach the mentioned limitations of claims 1 and 2 above but fail to teach a method, further including the steps of: attaching the new cookie values to an image request associated with a designated URL source associated with the second server; and sending the image request to the URL source. However, Davis et al. teaches a method, further including the steps of: attaching the new cookie values to an image request associated with a designated URL source associated with the second server; and sending the image request to the URL source (see Davis et al., ¶ 46). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner and Pogue et al. to a method, further including the steps of: attaching the new cookie values to an image request associated with a designated URL source associated with the second server; and sending the image request to the URL source in order to track the use and interaction of a user with a resource downloaded from a server on a network by use of a tracking program embedded in the resource and executable by a client (see Davis et al., ¶ 13).

44. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner, Pogue et al., and Davis et al. as applied to claims 1-3 above, and further in view of Shrader et al. (6,374,359). Wagner, Pogue et al., and Davis et al. teach the mentioned limitations of claims 1-3 above but fail to teach a method, further including the step of decoding the new cookie values to obtain the web browsing data. However, Shrader et al. teaches a method, further including the step of decoding the new cookie values to obtain the web browsing data (see Shrader et al., col. 2, lines 45-64). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner, Pogue et al., and Davis et al. to a method, further including the step of decoding the new cookie values to obtain the web browsing data in order to provide an architecture for the dynamic use and validation of HTTP cookies for authentication by an application running on a web server (see Shrader et al., col. 1, lines 62-65).

45. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner, Pogue et al. and Davis et al. Wagner, Pogue et al. and Davis et al. teach a method, further including the steps of: compiling the web browsing data into a web page traffic report; and posting the report for viewing over the wide area network (see Pogue et al., col. 4, lines 30-60).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/R. N. S./

Examiner, Art Unit 2141

01/22/2009

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444